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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/842,683

04/27/2001

Kazuharu Maeda

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09/11/2006

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

WASSUM, LUKE S

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,683

Applicant(s)

MAEDA ET AL.

Examiner

Luke S. Wassum

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-18 is/are allowed.
- 6) ☒ Claim(s) 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Applicants' amendment, filed 25 July 2006, has been received, entered into the record, and considered.
2. As a result of the amendment, claims 15, 16 and 18 have been amended, and claims 12 and 13 have been canceled. Claims 1-11 and 21-26 have been previously canceled. Claims 14-20 remain pending in the application.

The Invention

3. The claimed invention is a system for allowing a user to prepare a parts check list.

Priority

4. The Applicants' claim to foreign priority under 35 U.S.C. § 119 to Japanese Patent Applications JP 2000-132386, filed 1 May 2000, JP 2000-143486, filed 16 May 2000, JP 2000-200849, filed 7 July 2000, and JP 2000-209874, filed 11 July 2000, is acknowledged. The priority papers filed under 35 U.S.C. § 119(a)-(d) supporting the Applicants' claim to foreign priority have been received and entered into the record.

5. The subject matter of the elected claims (12-20) corresponds only to Japanese Patent Application JP 2000-132386. As such, the priority date established for this application is 1 May 2000.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Costello et al.** (U.S. Patent Application Publication 2002/0007225).

8. Regarding claim 19, **Costello et al.** teaches a parts check list preparing system as claimed, comprising the steps of:

- a) in addition to fetching the graphics data of a part necessary for preparing a parts checklist that shows parts information in a tabular form from a database comprising the graphics data of parts and the parts data thereof, causing a display device to present a layout based on said graphics data on display (see disclosure that the technical documents, including parts catalogs, are retrieved, paragraphs [0069]-[0076], and particularly paragraph [0076]; see also disclosure of the display of graphical reproductions of parts and assemblies, paragraph [0090] and Figure 10);
- b) after selecting the part in the layout on display, fetching the parts data corresponding with the graphics data of the selected part from the database (see disclosure of selection of parts through visual navigation of the schematic diagrams, paragraph [0046]);
- c) arranging the acquired parts data into a list and causing the display device to present the list together with the layout (see disclosure that detailed replacement part data is retrieved based upon selection of specific parts in schematic diagrams, paragraph [0012]; see also disclosure of the parts ordering module, paragraphs [0010], [0046] and [0061]);
- d) automatically preparing the parts check list based on the parts list (see disclosure of the parts ordering and parts tracking system, paragraphs

[0028]; see also disclosure of the parts ordering module, paragraphs [0010], [0046] and [0061]); and

e) ordering the parts by transmitting the prepared parts check list based on the parts list (see disclosure that the parts requisition center 22 and the service shop 16 may be linked via a global network, such as the Internet and the World Wide Web, paragraph [0026]; see also disclosure that the system provides parts ordering and parts tracking via communications with the parts requisition center 22, paragraph [0028]).

9. Regarding claim 20, **Costello et al.** additionally teaches a parts check list preparing system embodied in a computer program in a computer-readable storage medium (see paragraph [0002]).

Allowable Subject Matter

10. Claims 14-18 are allowed.

Response to Arguments

11. Applicant's arguments filed 25 July 2006 have been fully considered but they are not persuasive.

12. Regarding the Applicants' argument that the **Costello et al.** reference fails to teach the limitation of 'ordering the part by transmitting the prepared checklist based on the parts list', the examiner respectfully disagrees.

The first sentence of paragraph [0046] discloses that the parts ordering module is available to the technician via the portable unit. The last sentence of paragraph [0046] discloses that the parts ordering module can be used to mark a part for delivery to the service yard (clearly a parts list). The first sentence of paragraph [0061] discloses that when a new part is needed, the portable unit communicates with the service shop to requisition the part.

These three disclosures, taken together, clearly anticipate the claimed limitation that the part is ordered by transmitting the prepared checklist based on the parts list.

The rejection of record is maintained.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Art Unit: 2167

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
6 September 2006